

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MERRIT N. JACOBS

Appeal No. 96-1809
Application 08/094,724¹

ON BRIEF

Before METZ, HANLON and PAK, Administrative Patent Judges.
HANLON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final
rejection of claim 1. Claims 2 and 4-11 are also pending in
the application. Claim 2 has been objected to as being

¹ Application for patent filed July 21, 1993.

Appeal No. 96-1809
Application 08/094,724

dependent upon rejected independent claim 1 and claims 4-11
have been allowed by the examiner.

Claim 1 reads as follows:

1. A method of dispensing a liquid sample onto a test element, said element having a test volume subtending a surface area for that volume for receiving said sample, the method comprising the steps of:

a) applying onto a transfer element having a liquid-impermeable surface for supporting a liquid, a quantity of liquid sample over substantially all of said supporting surface, and

b) placing the transfer element liquid-supporting surface in contact with all of said surface area of a test element at once, thereby transferring substantially all of the liquid sample on said surface of said transfer element as a surface-dispersed quantity to said test element without the need for extensive horizontal flow over said test element surface area.

The sole issue in this appeal is whether claim 1 was properly rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Harrison.²

Discussion

² U.S. Patent No. 3,776,184 to Harrison granted December 4, 1973 (hereinafter "Harrison").

Claim 1 is directed to a method of dispensing a liquid sample onto a test element, the test element having a test volume subtending a surface area for receiving the sample.

The method comprises:

- a) "applying onto a transfer element having a liquid-impermeable surface for supporting a liquid," a quantity of liquid sample over the supporting surface, and
- b) placing the transfer element supporting surface "in contact with all of said surface area of a test element at once," thereby transferring substantially all of the liquid sample as a surface-dispersed quantity to the test element.

Harrison discloses an apparatus for applying liquid samples to a surface. A dispensing device supports a series of separate dispensing elements each comprising a closed or substantially closed loop (34, 92) defining a reception area for a film of solution (col. 3, lines 14-44). In operation, the loop retains a film or droplet of solution which is subsequently deposited on a sheet member by contacting the loop with the sheet member (col. 4, lines 27-35). According to Harrison, the dispensing elements may be formed from resilient wire such as stainless steel spring wire bent into

shape or from a plastic material such as nylon (col. 3, lines 30-32 and 53-55). In another form, the dispensing elements are constructed from a group of straight fibers resembling a small brush (150) (col. 3, lines 56-59).

Harrison fails to describe:

1. "applying onto a transfer element having a liquid-impermeable surface for supporting a liquid," a quantity of liquid sample over the supporting surface, and
2. "placing the transfer element liquid-supporting surface in contact with all of said surface area of a test element at once."

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros., Inc. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

- A. Harrison fails to describe "applying onto a transfer element having a liquid-impermeable surface for supporting a liquid," a quantity of liquid sample over the supporting surface

At the outset, we note that there appears to be a dispute as to the interpretation of claim 1. More specifically, there appears to be a dispute as to whether claim 1 only requires

that the transfer element be constructed from a material having an impermeable surface or whether the claim requires that the surface of the transfer element as a whole be impermeable.

An examination of the specification reveals that claim 1 requires the surface of the transfer element as a whole to be impermeable. See In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983) (during patent examination claims in an application are to be given their broadest reasonable interpretation consistent with the specification); In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art."); In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) (claim cannot be read in a vacuum, but rather must be read in light of specification

to thereby interpret limitations explicitly recited in claim).

According to appellant's specification (p.9, lines 9-24):

Referring to FIG. 1, a transfer element 10 is shown having a main body 2 comprising an upper surface 4 and a preferably circular lower surface 6. The shape of lower surface 6 may be varied, but preferably should be congruent with the shape of the test surface area to be contacted, whatever that may be.

Referring to FIG. 2(a), lower surface 6 is defined, in part, by a liquid-supporting portion 7 defined by a series of substantially parallel, V-shaped grooves 8, disposed over the majority of the area of surface 6. The shapes and depths of grooves 8, however, may be varied to be rectangular, convex, concave, U-shaped, etc. Alternate configurations can also be provided for defining liquid supporting portion 7; for example, a diamond-like pattern such as illustrated in FIG. 2(b).

See also Specification, p.10, lines 7-9 ("it is preferred that lower surface 6 be made from a compliant and liquid-impermeable material").

Although we agree with the examiner that the loop or transfer element in Harrison is constructed from a material having an impermeable surface (Answer, p.3), we agree with appellant that the surface of the transfer element as a whole is not impermeable. See Brief, p.3 ("liquid does 'pass through' the loop 34").

As for the brush (150), we agree with appellant that
(Reply Brief, p.2):

[T]he brush is fluid permeable because any liquid
penetrates between the fibers of the brush, making
the brush permeable as a whole.

The examiner has failed to establish otherwise. In re
Oetiker,
977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)
(the examiner bears the initial burden of presenting a prima
facie case of unpatentability).

B. Harrison fails to describe "placing the transfer
element liquid-supporting surface in
contact with all of said surface area of a test
element at once"

Claim 1 further requires that the transfer element
liquid-supporting surface be in contact with all of the
surface area of the test element at once. Harrison fails to
describe this additional limitation.

In Harrison, the transfer element liquid-supporting
surface comprises a loop, and the surface area of the test
element comprises a sheet member 5 (Figure 2). According to
Harrison (col. 4, lines 28-33):

Appeal No. 96-1809
Application 08/094,724

When the support member 27 reaches the delivery position P2 the loops 92 will just gently contact the [sheet] member 5 in a clean non-skidding movement to apply a deposit of the solution of known volume to the upper surface of the [sheet] member 5.

However, a hollow defined by the perimeter of the loop does not contact sheet member 5. Therefore, all of the surface of sheet member 5 is not contacted by the liquid-supporting surface in Harrison as required by claim 1.

For the reasons stated above, the decision of the examiner is reversed.

REVERSED

Appeal No. 96-1809
Application 08/094,724

| | | | |
|--------|-----------------------------|---|---------------|
| | ANDREW H. METZ |) | |
| | Administrative Patent Judge |) | |
| | |) | |
| | |) | |
| | |) | |
| | ADRIENE LEPIANE HANLON |) | BOARD OF |
| PATENT | Administrative Patent Judge |) | APPEALS AND |
| | |) | INTERFERENCES |
| | |) | |
| | CHUNG K. PAK |) | |
| | Administrative Patent Judge |) | |

J. Jeffrey Hawley
Eastman Kodak Company
Patent Legal Staff
Rochester, NY 14650-2201

Appeal No. 96-1809
Application 08/094,724

ALH/cam